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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/833,998	04/12/2001	Judith L. Erb	3060.00018	6598

7590 11/09/2005

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EXAMINER
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HOFFMANN, JOHN M

ART UNIT	PAPER NUMBER
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1731

DATE MAILED: 11/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/833,998

Applicant(s)

ERB ET AL.

Examiner

John Hoffmann

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 October 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 62-64 is/are pending in the application.
- 4a) Of the above claim(s) 64 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 62 and 63 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of Group I, claims 62-63 in the reply filed on 27 May 2004 is acknowledged. The traversal is on the ground(s) that both inventions are directed to a method. This is not found persuasive because claim 64 is directed to a means – which is not a method. Furthermore, claim 64 has no steps.

The requirement is still deemed proper and is therefore made FINAL.

Claim 64 is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 27 May 2004.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 63 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The statute implicitly refers to a single process/method. However, claim 63 is an invention of “methods” not a “process, machine, manufacture or composition”. It is noted examiner would not know how to examine an invention which is/are “methods”. And whether a prior art that encompasses one of the methods would read on the claim, or if all methods must be contained in the prior art.

### ***Claim Objections***

Claim 63 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

As per line 4 of claim 62, the carrier is filled with fiber sections. However claim 63, lines 1-2 suggest that the sections can be in more than one carrier. Thus claim 63 expands the scope of claim 62 (not limiting it) from one carrier carrying the sections to a scope which permits more than one carrier.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 62-63 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the methods known to the inventor, does not reasonably provide enablement for every conceivable method. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

### **From MPEP 2164.08(a)    *Single Means Claim***

A single means claim, i.e., where a means recitation does not appear in combination with another recited element of means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. In re Hyatt, 708 F.2d 712, 714-715, 218 USPQ 195, 197

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(Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor.). When claims depend on a recited property, a fact situation comparable to Hyatt is possible, where the claim covers every conceivable structure (means) for achieving the stated property (result) while the specification discloses at most only those known to the inventor.

Whereas claim 62 is directed to a single step claim (rather than a single means claim) it is presumed that the same rationale (as set forth in In re Hyatt) would be proper. Namely, the claims are unduly broad. The claim has no steps, rather the claim is directed to all methods that result in the end product. The claim is directed to every conceivable method while the specification discloses at most only those known to the inventor.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 62-63 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are replete with language which make the claims impossible to understand as to what is being claimed. Applicant is required to review and correct all problems.

Some examples of problems: Missing antecedent basis for "said clad fiber sections", "the solutions", "said fiber cladding means", "the protective sheathes" in part (b) of claim 62. Claim 62 has a preamble and two parts (a) and (b) – it is unclear if the method comprises those two steps, or if it consists of those two steps, or if they are

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product by process types steps that serve to identify the fibers prior to method, or something else.

Claim 62, line 2 refers to “target analytes”, this reads on a nebulous mental step conducted prior to the manipulative steps of the claimed process, hence rendering the present process claim unclear in meaning in scope. If applicant wishes to patent detail controls over the recited process, the process steps must be positively recited. See Seagram & Sons Inc. vs Marzall, 84 USPQ 180. In other words, whether or not someone is targeting something is a purely mental step. It is unclear whether one of ordinary skill doing exactly the same thing that applicant does, but does not have a target, would infringe not – and thus making a patent granted on the claims unenforceable because there is no way to read one’s mind. Line 4 of claim 62: it is unclear if “a plurality of fiber” should be “a fiber” or “a plurality of fibers”: and if it “filled with fiber sections”, how could it hold any more fibers – it would have to be not yet filled to be able to hold anything else.

In claim 63, lines 1-2 refer to carriers and a plurality of clad fiber sections – it is unclear if these are in addition to the carrier and the sections of claim 62. And if they are the same, it does not make sense because the fiber sections are the one carrier, thus cannot be in more than one carrier.

Again, the above are just a few examples of what makes the claims indefinite. The burden is upon applicant to make the claims understandable to one of ordinary skill.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 62 is rejected under 35 U.S.C. 102(b) as being anticipated by Partin 5082630.

Claim interpretation: The invention is directed to a method for making sensor fibers. See col. 1, lines 20-23 which refers to such sensors – it is inherent that they were made/manufactured. It is clear they are sensitive to their target analytes (col. 1, lines 20-40). As to the limitation that the fibers “may be chemically sensitized together...”: since this is optional, it does not substantially limit the claims. There is nothing would prevent the sensors from being sensitized together as claimed.

As to parts (a) and (b) it is deemed that such refer to the ancillary fiber sections. Again, the sensors may (or may not) be sensitized by using the carrier which also has fiber sections. One looking at a sensor cannot ascertain whether or not a carrier ever carried it, or if the carrier also had some sections in it. Step (a) does not state what is “cut from a longer length” – thus it is presumed to be the sections, not the sensors – because by normal U.S. English grammar, adjectival phrases (such as “cut from a longer length”) modify the nearest noun – in this case the fiber sections. Furthermore, step (b) refers to the sections – and by parallel construction one would presume that claim (a) refers to the sections.

***Claim Rejections - 35 USC § 103***

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.



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Claim 63 rejected under 35 U.S.C. 103(a) as being unpatentable over Partin 5082630.

Examiner takes Official Notice that trucks, hand carts, forklifts, etc. are commonly used to transport large number of items within factories and/or between factories. It would have been obvious to make plural of the Partin sensors so that numerous people can search for illegal drugs in many places, and/or to sell them and make lots of money.

**From MPEP 2144.04**

**B. Duplication of Parts**

In re Harza, 274 F.2d 669, 124 USPQ 378 (CCPA 1960) (Claims at issue were directed to a water-tight masonry structure wherein a water seal of flexible material fills the joints which form between adjacent pours of concrete. The claimed water seal has a "web" which lies \*\* in the joint, and a plurality of "ribs" \*\* >projecting outwardly from each side of the web into one of the adjacent concrete slabs. <The prior art disclosed a flexible water stop for preventing passage of water between masses of concrete in the shape of a plus sign (+). Although the reference did not disclose a plurality of ribs, the court held that mere duplication of parts has no patentable significance unless a new and unexpected result is produced.).

It would have been obvious to use a truck, forklift, hand cart, or other similar device so as to transport multiple sensors simultaneously, because it is quicker and more efficient to transport multiple items simultaneously, than transferring them one at a time. It is deemed that each sensor, has a clad fiber section: which corresponds to part 49 as shown in figure 3 of Partin: 49 is the protective sheathing means. The means is sealed to the end of the section, but not the end of the entire fiber.

As to the sealing being done "through a series of processing steps...(a)...; and (b)...; and (c)...; and (d)...; and (e)...; and (f)....", such is inferred to define how the sealing was preformed, that is, it is defining the structure of the sections in a product-by-

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process manner. In other words: it is deemed that steps (a)-(f) are not process steps of the claim, rather they merely identify the structure of the sections.

The courts have been holding for quite some time that “—in spite of the fact that a product-by-process claim may recite only process limitations, it is the product which is covered by the claim and not the recited process steps.” (In re Hughes, 182 USPQ). Also, “—patentability of a claim to a product does not rest merely on a difference in the method by which that product is made. Rather, it is the product itself which must be new and unobvious.” (In re Pilkington, 162 USPQ 147).

The Patent Office bears a lesser burden of proof in making out a case of prima facie obviousness for product-by-process claims because of their peculiar nature. In re Fessmann, 489 F.2d 742, 744, 180 USPQ 324, 326 (CCPA 1974). Once the examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. In re Marosi, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983).

It appears that the Partin fiber has no characteristics which would serve to distinguish it from one made by a method using steps a-f.

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the one or more carriers being used to convey a plurality of fibers must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate

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prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Conclusion***

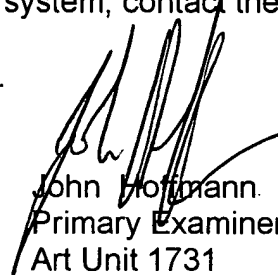
Whereas it is Office general policy to perform a complete search of the invention during the first examination, Examiner was not able to understand fully what is being claimed do to the informalities of the claim language. Thus, Examiner could not and did not conduct a full search of the method. A complete search will be made once the claims unambiguously and specifically recite the invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hoffmann whose telephone number is (571) 272 1191. The examiner can normally be reached on Monday through Friday, 7:00- 3:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
John Hoffmann  
Primary Examiner  
Art Unit 1731

11-7-05

jmh